

REMARKS

This Amendment is made in response to the Office Action of October 14, 2008. Applicant submits herewith a Request for Extension of Time whereby this Request for Continued Examination may be timely filed.

Applicant respectfully asserts that the Examiner has failed to construct a record that satisfies the "sufficient evidence" standard to support his rejection of claims 65-99 and 182-247, 249, 250 and 252-334 as being anticipated under 35 U.S.C. §102(b). In particular, the Examiner has failed to show that the cited Bornstein Patent discloses each element of the rejected claims. The Supreme Court has held that decisions of the U.S. Patent and Trademark Office (USPTO) must meet a new burden of proof. *Dickenson v. Zurko*, 527 U.S. 150, 50 USPQ2d 1930 (1999). The Federal Circuit now reviews findings of fact under the "substantial evidence" standard of the Administrative Procedure Act ("APA") to support a conclusion that a claim at issue is unpatentable. *In re Gartside*, 203 F.3d 1305, 1315, 53 USPQ2d 1769, 1775 (Fed. Cir. 2000). To satisfy the "substantial evidence" standard and, therefore, establish a *prima facie* case of anticipation under 35 U.S.C. 102, the USPTO and the Examiner have the initial burden of establishing unpatentability. *In re Mullin*, 481 F.2d 1333, 1336, 179 USPQ 97, 100 (CCPA 1973). The USPTO (whether an Examiner or the Board of Patent Appeals and Interferences ("Board")) must make the necessary findings of fact to construct an administrative record containing evidence to support these findings, accompanied by reasons to support a conclusion of unpatentability. *In re Kotzab*, 217 F.3d

1365, 55 USPQ2d 1313 (Fed. Cir. 2000); *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001) ("*Zurko IV*"). After the *Zurko IV* decision, whether a rejection on prior art is sustained by the Federal Circuit depends on whether the USPTO has made an adequate record.

A *prima facie* case requires substantial evidence of all the limitations of the claim being examined. In *In re Kotzab*, the Federal Circuit stated that the mere identification in an applied reference of a particular component that corresponds to a claimed recitation does not satisfy the "substantial evidence" standard. Rather the USPTO is required to make particular findings as to the reasons that a person of ordinary skill in the art, with no knowledge of the claimed invention, would have selected from the applied reference the noted recitations as claimed. To support a conclusion that a claimed invention lacks novelty under 35 U.S.C. §102, a single reference must teach all of the elements of a claim. *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1379, 231 USPQ 81, 90 (Fed. Cir. 1986). As will be pointed out below, there are significant recitations of each of the claims 65-99 and 182-333 which are not fairly met by the teachings of the Bornstein Patent as identified in detail below. Thus, it is clear that the *Hybritech* decision of the CAFC requires the Examiner to show that a single reference, i.e. the Bornstein Patent, must teach all of the elements of a claim. The Examiner has established his record by identifying and reproducing those parts of Bornstein upon which he relies to sustain his anticipation rejection of each the presented claims. In the following, applicant will demonstrate from the Examiner's record, which includes those portions of Bornstein upon which he relies for his anticipation rejections, that Bornstein at a minimum fails to disclose at least one recitation of each claim presented in this application. A review of the Examiner's record indicates that the Examiner

has failed to so apply the Bornstein Patent to each recitation of the claims presented in this application.

In respect to paragraph 2, claims 65-99, 182-247, 249, 250, and 252-334 are being anticipated by the Berger Patent No. 6,414,683. Further Applicant has added new claims 335-338. The aforementioned recitations readily distinguish the Berger patent.

Further, Applicant respectfully traverses the rejection of claims 65-89, 95-99, 182-247, 249, 250, 252-258, 262-281, 285-307 and 312-330 as being un-patentable subject matter under 35 USC 101. The undersigned respectfully asserts that Applicant's invention satisfies the test enunciated by the Federal Circuit in *Bilski*. *Bilski* teaches a two stage test, i.e., changing the state of a product (changing the state of rubber in *Diehr*), and having a tie to a machine. Applicant respectfully asserts that Applicant clearly satisfies *Bilski*'s change of state test (assembling a logo with an item of clothing) and, therefore, is deemed to be statutory subject matter.


Further, Applicant respectfully asserts that claims 95 and 312 are means plus function claims and should be interpreted under 35 USC 112, paragraph 6, which requires a comparison of the functional language of these claims with the corresponding structure as described in their specification, which for example may comprise the programmed computer as shown in Fig. 1.

In view of the above discussion, Applicant respectfully asserts that each claim is now directed to statutory subject matter analyzed matter, and is now in condition for allowance, which action is respectfully requested. If the Examiner is unable to allow this application, he is requested to

call the undersigned to suggest that response whereby this application will be speedily prosecuted to issuance.

The Commissioner for Patents is authorized to charge any additional fees or credit any overpayments to Deposit Account No. 03-3415.

Respectfully submitted,



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